

REMARKS

Reconsideration of the present application is respectfully requested. Claim 21 has been amended to cure a grammatical error. Claims 1 – 35 are currently pending.

Rejections based on 35 U.S.C. § 102

Claims 1 – 35 stand rejected under 35 U.S.C. §102(a) as being anticipated by “Simplifying the Management of Large Photo Collections” by Girgensohn, *et al.* (“Girgensohn”). This rejection is respectfully traversed.

Declaration under 37 C.F.R. § 1.131

The present application was filed on January 23, 2004, while Girgensohn relies on a publication date of September 1, 2003. *See* Notice of References Cited. Applicants, however, conceived of and reduced their invention to practice before the publication date of the Girgensohn reference. Thus, the Girgensohn reference does not qualify as prior art.

In response to the previous Office Action, Applicants submitted a Declaration under 37 C.F.R. § 1.131, along with Exhibits A and B, to overcome the present rejection. This Declaration, along with Exhibits A and B, are resubmitted herewith. In the Declaration, Applicants swear behind the effective date of the Girgensohn reference and attest that the date of conception of the present invention was at least before the publication date of the Girgensohn reference. Exhibits A and B provide written evidence to support such a date of conception. Exhibits A and B also show an actual reduction to practice prior to the publication of the Girgensohn reference.

The current Office Action indicates that the Declaration is ineffective to overcome the Girensohn reference because “there is no proof of due diligence between the span

of 10/31/2003 through the effective filing date of 1/23/2004.” However, the Applicants are not required to provide evidence of due diligence from 10/31/2003 to 1/23/2004 because Applicants actually reduced their invention to practice before September 1, 2003, the effective date of the Girgensohn reference. Section 1.131 of Title 37 of the Code of Federal Regulations requires the presentation of evidence demonstrating a “reduction to practice prior to the effective date of the reference, **or** conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application.” 37 CFR 1.131 (emphasis added). Because Applicants have submitted evidence of a “reduction to practice prior to the effective date of” the Girgensohn reference, Applicants are not required to also prove diligence until their filing date. *See* 37 CFR 1.131.

Evidencing an actual reduction to practice prior to September 1, 2003, Applicants have provided Exhibit A. Exhibit A is a press release announcing the release of a software product titled “Microsoft® Digital Image Suite 9” on July 29, 2003. As demonstrated by Exhibit B, Microsoft® Digital Image Suite 9 embodies the claimed invention, and, thus, the release of this product on July 29, 2003 is evidence that Applicants actually reduced their invention to practice prior to the effective date of the Girgensohn reference.

To prove that Microsoft® Digital Image Suite 9 embodies the claimed invention, Applicants have provided Exhibit B, which includes a series of screen shots generated by Microsoft® Digital Image Suite 9. These screen shots prove that the Digital Image Suite 9 product, released on July 29, 2003, is an actual reduction to practice of the claimed invention. A mapping of claim 1 to the content of Exhibit B is provided as an example:

<p>Claim 1: A computer-implemented method for presenting a set of items to a user, the method comprising: dividing said set of items into one or more groups according to a selected characteristic;</p>

presenting at least a portion of said set of items in accordance with said groups to the user on a display;

Pages 1 and 2 of Exhibit B illustrate the presentation of items (i.e., photographs) in groups, as dictated by a selected characteristic. For example, in the top screen shot on page 1 the photos are divided into a December 2003 group and a September 2003 group.

**presenting a listing of said groups on said display; and
indicating on said display which of said groups contain one or more items currently visible to the user.**

The center, vertical column of the screen shots displayed on pages 1 and 2 provides a listing of the groups used to divide the photos. In addition, a horizontal, gray bar indicates the groups currently visible to the user in the right-most pane. For instance, the gray bar in the first screen shot on page 1 indicates the images from December 2003 and September 2003 are presently being displayed to the user. Because the Microsoft® Digital Image Suite 9 product includes each and every claimed aspect of the present invention, it is an actual reduction to practice that pre-dates the effective date of the Girgensohn reference.

Applicants further note that the screen shots provided by Exhibit B are similar to FIGS. 2A-C and FIGS. 5A-C of the present application and that these figures also indicate their creation by Microsoft® Digital Image Suite 9. As such, the specification of the present application, in discussing FIGS. 2A-C and FIGS. 5A-C, may provide further guidance regarding the mapping of the claimed invention to the interface provided by Microsoft® Digital Image Suite 9.

In sum, the Declaration and written evidence demonstrate that Applicants conceived of the present invention and reduced it to practice before the effective date of the Girgensohn reference. As such, the Office Action can no longer maintain a valid rejection under

35 U.S.C. § 102(a) as the Girgensohn reference does not qualify as prior art. Accordingly, withdrawal of the rejection of claims 1 - 35 under 35 U.S.C. §102(a) is respectfully requested.

Conclusion

For the reasons stated above, claims 1 – 35 are in condition for allowance. If any issues remain which would prevent issuance of this application, the Examiner is urged to contact the undersigned prior to issuing a subsequent action. The Commissioner is hereby authorized to charge any additional amount required, or credit any overpayment, to Deposit Account No. 19-2112.

Respectfully submitted,

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